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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,609	03/11/2005	Alastair McAlpine Marr	II/2-22748/MA 2226/PCT	5227
324 7590 01/10/2008 JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591			EXAMINER NILAND, PATRICK DENNIS	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 01/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,609

Applicant(s)

MARR ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/05, 9/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed “hyperdispersants” and “synergist additives”, does not reasonably provide enablement for all of the encompassed “hyperdispersants” and “synergist additives”. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. The instant claims recite “hyperdispersants” and “synergist additives” without specifying the “hyperdispersants” and “synergist additives”. Therefore the claims encompass all possible “hyperdispersants” and “synergist additives”. The instantly claimed “hyperdispersants” and “synergist additives” reads on an infinite number of compounds resulting from the potentially infinite number of “hyperdispersants” and “synergist additives”. In re Wands has 8 criteria, (MPEP 2164.01(a)), as shown below.

(A)The breadth of the claims;

(B)The nature of the invention;

(C)The state of the prior art;

(D)The level of one of ordinary skill;

(E)The level of predictability in the art;

(F)The amount of direction provided by the inventor;

(G)The existence of working examples; and

(H)The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

It is noted that the instant claims read on all potential “hyperdispersants” and “synergist additives” which encompasses an infinite number of compounds (Wands factor A). The specification does not describe how to choose all “hyperdispersants” and “synergist additives”, how to make all such “hyperdispersants” and “synergist additives”, or how to select those “hyperdispersants” and “synergist additives” from the infinite list thereof which will function as required in the instant invention (Wands factors F, G). It would require an infinite amount of experimentation to determine how to make all of the “hyperdispersants” and “synergist additives” encompassed by the instant claims and another infinite amount of experimentation to determine which of the infinite list of compounds would function in the instantly claimed invention as required (Wands factor H). Chemistry is an unpredictable art (Wands factor E). The ordinary skilled artisan has not imagined nor figured out how to make all of the “hyperdispersants” and “synergist additives” encompassed by the instant claims yet (Wands factors C, D, E, F, G, and H). The enabling disclosure is not commensurate with the full scope of the claimed “hyperdispersants” and “synergist additives”.

2. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed substituents, does not reasonably provide enablement for all of the encompassed substituents. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. The instant claims recite “substituted” without specifying the substituents. Therefore the claims encompass all possible substituents. The instantly claimed “substituted” reads on an infinite number of compounds resulting from the potentially infinite number of

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substitutions which can be performed on the recited compounds. In re Wands has 8 criteria, (MPEP 2164.01(a)), as shown below.

(A)The breadth of the claims;

(B)The nature of the invention;

(C)The state of the prior art;

(D)The level of one of ordinary skill;

(E)The level of predictability in the art;

(F)The amount of direction provided by the inventor;

(G)The existence of working examples; and

(H)The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

It is noted that the instant claims read on all potential substitutions of the recited compounds which encompasses an infinite number of compounds (Wands factor A). The specification does not describe how to make all such substituents, how to add them to the claimed compounds, nor how to select those substituents from the infinite list thereof which will function as required in the instant invention (Wands factors F, G). It would require an infinite amount of experimentation to determine how to make all of the substituents encompassed by the instant claims and another infinite amount of experimentation to determine which of these substituted compounds would function in the instantly claimed invention as required (Wands factor H). Chemistry is an unpredictable art (Wands factor E). The ordinary skilled artisan has not imagined nor figured out how to make all of the substitutions encompassed by the instant

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claim of “substituted” yet (Wands factors C, D, E, F, G, and H). The enabling disclosure is not commensurate with the full scope of the claimed “substituted”.

3. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed modifications of the claimed rosins, does not reasonably provide enablement for all of the encompassed modifications. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. The instant claims recite “modified rosins” without specifying the modifications. Therefore the claims encompass all possible modifications. The instantly claimed “modified rosins” reads on an infinite number of compounds resulting from the potentially infinite number of modifications which can be performed on the recited compounds. In re Wands has 8 criteria, (MPEP 2164.01(a)), as shown below.

(A)The breadth of the claims;

(B)The nature of the invention;

(C)The state of the prior art;

(D)The level of one of ordinary skill;

(E)The level of predictability in the art;

(F)The amount of direction provided by the inventor;

(G)The existence of working examples; and

(H)The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

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It is noted that the instant claims read on all potential modifications of the recited rosins which encompasses an infinite number of compounds and processes of modifying rosins (Wands factor A). The specification does not describe how to make all such modified rosins, how to add them to the claimed compositions, nor how to select those modifications from the infinite list thereof which will function as required in the instant invention (Wands factors F, G). It would require an infinite amount of experimentation to determine how to make all of the modifications encompassed by the instant claims and another infinite amount of experimentation to determine which of these modified rosins would function in the instantly claimed invention as required (Wands factor H). Chemistry is an unpredictable art (Wands factor E). The ordinary skilled artisan has not imagined nor figured out how to make all of the modifications encompassed by the instant claim of “modified” yet (Wands factors C, D, E, F, G, and H). The enabling disclosure is not commensurate with the full scope of the claimed “modified rosin”.

4. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claims recite “synergist additive”. It is unclear what property or properties this additive is to give synergy regarding and with what it is to give this synergy.

B. The instant claim 4 recites a molecular weight regarding a polymeric compound. It is unclear what type of polymeric molecular weight is intended, e.g. number average, weight average, z average, viscosity average, etc.

C. Claim 4 recites “100’000”. It is unclear what is intended by this recitation.

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D. The instant claims recite amounts in percentages. It is unclear if the percentages are based on weight, volume, moles, or some other basis. It is further unclear if they are based on the entire composition or some portion thereof.

E. It is unclear how one would achieve the upper amount of component e given that the lowest amounts of a through d would not allow for 40% of e.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 6099631 Tregub et al..

Tregub discloses a pigment composition comprising the instantly claimed amounts of organic pigment, hyperdispersant, including the applicant's Solsperse hyperdispersants, synergist, including the applicant's Solsperse synergists, and solvent at column 1, lines 10-21, which falls within the scope of the instant claim 2, column 2, lines 53-67; column 3, lines 1-67, particularly 17-32 of which 31-32 has the amount of pigment of the instant claims, lines 32-36, which is the instantly claimed component b, lines 50-51, which is the instantly claimed amount of component

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d, and lines 62-67, which is the instantly claimed amount of component b; column 4, lines 1-19, particularly 2-4, lines 13-19, which encompasses the instantly claimed amounts of component c, and the remainder of the document. The instant claims do not require any rosins due to the recitation of 0. The Solsperse hyperdispersants of the patentee appear to be those of the instant claims 3-4 based on the applicants description thereof and use of Solsperse 13000 at page 11 of the instant specification. The Solsperse synergists appear to be those of the instant claim 5 based on the applicant's description thereof at page 11 of the instant specification. Claim 8 continues to encompass 0 % of the recited rosins. The above composition falls within the scope of the instant claim 9, of which "printing ink for lithographic printing" is not seen as not encompassing the above discussed pigment compositions since these claims do not require further ingredients and "printing ink for lithographic printing" is not seen as requiring further ingredients necessarily and inherently. The patentee disperses the pigment composition into components in the instantly claimed amounts of claims 10-12 and the resulting compositions appear to be useful in lithographic printing when melted. See column 4, lines 25-33 and 47-67.

8. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6099631 Tregub et al..

Tregub discloses a pigment composition comprising the instantly claimed amounts of organic pigment, hyperdispersant, including the applicant's Solsperse hyperdispersants, synergist, including the applicant's Solsperse synergists, and solvent at column 1, lines 10-21, which falls within the scope of the instant claim 2, column 2, lines 53-67; column 3, lines 1-67, particularly 17-32 of which 31-32 has the amount of pigment of the instant claims, lines 32-36, which is the instantly claimed component b, lines 50-51, which is the instantly claimed amount of component

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d, and lines 62-67, which is the instantly claimed amount of component b; column 4, lines 1-19, particularly 2-4, lines 13-19, which encompasses the instantly claimed amounts of component c, and the remainder of the document. The instant claims do not require any rosins due to the recitation of 0. The Solsperse hyperdispersants of the patentee appear to be those of the instant claims 3-4 based on the applicants description thereof and use of Solsperse 13000 at page 11 of the instant specification. The Solsperse synergists appear to be those of the instant claim 5 based on the applicant's description thereof at page 11 of the instant specification. Claim 8 continues to encompass 0 % of the recited rosins. The above composition falls within the scope of the instant claim 9, of which "printing ink for lithographic printing" is not seen as not encompassing the above discussed pigment compositions since these claims do not require further ingredients and "printing ink for lithographic printing" is not seen as requiring further ingredients necessarily and inherently. The patentee disperses the pigment composition into components in the instantly claimed amounts of claims 10-12 and the resulting compositions appear to be useful in lithographic printing when melted. See column 4, lines 25-33 and 47-67.


It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the above discussed combinations of materials and amounts thereof in the compositions of Tregub because they are encompassed by the patentee and would have been expected to give the benefits of the pigment compositions discussed throughout Tregub.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Patrick D Niland', is positioned above the printed name.

Patrick D Niland
Primary Examiner
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